

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed December 2, 2004. At the time of the Final Office Action, Claims 1-12 were pending in this Application. Claims 1-12 were rejected. Claims 1-4 have been amended to further define various features of Applicants' invention. Claims 6-10 have been canceled and new Claim 13 is submitted. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1-10 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5740,389 issued to Shih-Gong Li et al. ("Li et al."). Applicants respectfully traverse and submit the cited art does not teach all of the limitations of the claimed embodiment of the invention. Li et al. is directed to a drag and drop operation wherein two windows are open simultaneously on a screen of a display device, a user can transfer a graphical object from a source window to a target window, wherein after dragging a cursor to the target window, the target window can be scrolled. The drag and drop operation of Li et al. is between two opened windows, wherein at least a portion of the contents of the target window are visible to the user at the commencement of the drag. In addition, after the drag and drop operation of Li et al., the source window remains open, unless manually closed, and thus, stays in a foreground position on the display device.

The presently claimed embodiment of the invention is directed, *inter alia*, to a program method to improve upon conventional tabbed dialogs/notebooks by enabling users to initiate a drag action on a visible register of a register dialog, *e.g.*, the register in the foreground, to a non-visible concealed register of a register dialog, wherein upon dragging onto the concealed register, the concealed register automatically becomes visible and is positioned in the foreground in place of the initially visible register from which the drag initiated, and allowing a drop into the originally concealed, but now visible register displayed in the foreground. Li et al. does not teach such an operation and is not directed to operations involving, *e.g.*, tabs, in which the presently claimed embodiment of the invention is particularly applicable. Withdrawal of the rejection and favorable action is requested.

Rejections under 35 U.S.C. §103

Claims 11-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Li et al., and further in view of U.S. Patent 5,638,505 issued to Kathleen Hemenway et al. (“Hemenway et al.”). Applicants respectfully traverse and submit the cited art combination, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

As noted above, Li et al. failed to teach an element of the claimed embodiment of the invention, namely a drag action initiated from a visible register in the foreground of the display of a register dialog to a concealed register of the register dialog, wherein upon movement to the concealed register, the concealed register’s contents are automatically displayed in the foreground, replacing the initially visible register, to allow for a drop action into the originally concealed, now visible register in the foreground. It is respectfully submitted that neither Li et al. nor Hemenway et al. combined or singularly teach and/or suggest such an operation. Thus, a *prima facie* case of obviousness has not been established and Applicants request withdrawal of the rejection.

In relation to Claims 11 and 12, it is respectfully submitted that Hemenway et al. do not teach the display of or designation of the possible acceptable drop locations. Hemenway merely shows all possible acceptable and non-acceptable drop locations and user has to select

a possible drop location to be informed whether or not the location can accept a drop. Thus, for this addition reason, Applicants request withdrawal of the rejection and formable action.

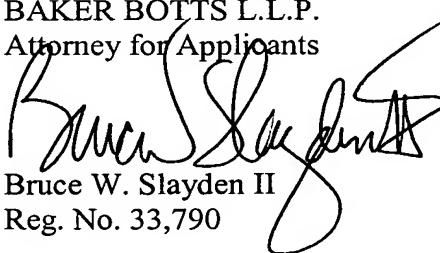
CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request (i) reconsideration of Claims 1-5, 11 and 12 as amended, and (ii) favorable consideration of new Claim 13.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2606.

Respectfully submitted,
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